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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,455	11/26/2001	Donald L. Mobley	8266-0740	7793

7590 11/05/2002
Timothy E. Niednagel
Bose McKinney & Evans LLP
135 N. Pennsylvania Street, Suite 2700
Indianapolis, IN 46204

EXAMINER

BARTZ, CLIFFORD T

ART UNIT PAPER NUMBER

3683

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No. 09/992,455	Applicant(s) MOBLEV ET AL.	
	Examiner Clifford Bartz	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 01 October 2002.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 7 and 12 is/are allowed.

6) ☒ Claim(s) 1-6, 8-11 and 13-20 is/are rejected.

7) ☒ Claim(s) 4 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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Part III DETAILED ACTION

Continued Examination

This application is specified by applicant as a divisional of parent application 09/263,039. However, it has been treated as a continuation application since it has not been properly "carved out" of its parent (the original claims have not been presented at the filing of this case, which is a requirement for filing a divisional). Applicant is required to alter the specification to reflect the above.

It is noted that applicant has not complied with the requirement above, presented in the first action.

Claim Rejections - 35 USC § 112

Claim(s) 1, 2, 3, 4, 5, 6, 8, 9, 10, 11, 13, 14, 15 is(are) rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to parent claim 1, applicant has not made clear in the newly added recitation what an "external side wall is " is, in line 6. "External" to what?

As to parent claim 11, applicant has not made clear in the newly added recitation what an "external surface" is, in line 8.

The dependent claims are rejected under 35 USC 112 as incorporating the defects of the claims from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:
A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 3, 5, 6, 9 is(are) rejected under 35 U.S.C. § 102(b) as being anticipated by

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Schultz ' 539 (cited in the parent application).

Schultz discloses base frame 12, including 22; patent support 20; sleeve 36; caster mounting tube 42 in Fig. 2; external side wall as the portion of 52 and/or 54 which faces 62, (a portion which is clearly "external" if the structure 28 is considered before 62 is welded to it; the welds being disclosed as 55 [see column 2, line 50] and are located at opposite vertical ends of 54).

Claim(s) 1, 2, 8 is(are) rejected under 35 U.S.C. § 102(b) as being unpatentable over Hall.

Hall discloses all the structure of the claimed device including: base frame 28; patient support 33; caster rectangular sleeves 54; caster rectangular mounting tubes 44; welds disclosed in column 4, line 57.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim(s) 10 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Schultz in view of Hilborn.

Schultz discloses all the structure of the claimed device as detailed above; except for rectangular cross-sectional shapes. Hilborn discloses rectangular cross-sectional mating shapes 12, 14. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a rectangular cross-sectional shape as shown in Hilborn 12 as a caster shape, since it has been held to be within the general skill of a worker in the art to make a change in form or shape on the basis of its suitability for the intended use as a matter of obvious design choice. In re Dailey, 149 USPQ47(CCPA 1976).

Claim(s) 11, 13, 14, 15 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson (both cited in the parent application).

Hilborn discloses the method claimed in that Fig. 1 shows the base frame of a bed 14; mounting tube 12 with a generally round cross-sectional shape 34 ; except for welding.

Carlson is relied upon merely to show that it is known in the art to provide welds 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the connection between the mounting tube and the base frame utilizing welds as disclosed by Carlson, in order to provide at least vertical immobility. As to claim 13, the combination of Hilborn and Carlson discloses all the structure of the claimed device as detailed above; except for the particular step of configuring the interior opening as having a square cross- sectional shape. It would have been obvious to one having ordinary skill in the art

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at the time the invention was made to have configured the interior opening as having any particular shape, since this step is performed prior to the forming step, and thus essentially imbricates the forming step; and further: applicant has not disclosed that this particular "configuring" step solves any stated problem, or is for any particular purpose and; it appears the claimed invention would perform equally well without the "configuring" step.

Claim(s) 16, 19, 20 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson (both cited in the parent application).

Hilborn discloses the method claimed in that Fig. 3 shows the base frame of a bed 33; mounting tube 44 with a square cross-sectional shape 34; caster et al 40: except for welding. Carlson is relied upon merely to show that it is known in the art to provide welds 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the connection between the mounting tube and the base frame utilizing welds as disclosed by Carlson, in order to provide at least vertical immobility.

Claim(s) 17, 18 is(are) rejected under 35 U.S.C. § 103 as being unpatentable over Hilborn in view of Carlson (both cited in the parent application).

Hilborn discloses the method claimed in that Fig. 2, 3 shows the structure of the parent claim, except for a brake and and locking mechanism. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a braking and locking mechanism for the caster; since the examiner takes Official Notice that braking and locking mechanisms used for casters are known in the brake art and it would be within the level

of ordinary skill in the art for a routineer to combine a braking and locking means of this nature with Hilborn for positioning purposes. It is maintained that in such an arrangement as Hilborn, the contemplation of the use of brakes is well within the capability of a routineer in the art.

Response to Amendment

Applicant's arguments filed 10/1/02 have been fully considered but are not deemed to be persuasive.

Particularly with regard to claim(s) 1 and Schultz '359; applicant firstly argues no patient support is disclosed, overlooking the statement, repeated above, which indicates that the patient support is disclosed as 20. Secondly, applicant argues that there is no disclosure of the "external surface of an external side wall abutting the base frame". However, applicant has added recitation which is vague, and thus the "external side wall" may be considered as being disclosed as in for example, the portion of 52 and/or 54 which faces 62; a portion which is clearly "external" if the structure 28 is considered, before 62 is welded to 28; the welds being disclosed as 55. Thirdly, applicants argument regarding welds is moot in view of the anticipation rejection newly presented.

Applicant has argued with regard to the rejection of claim(s) 1, 2, 8: that Hall does not provide any hint or suggestion for a patient support. However, the limitation "patient support" used in the claim is a functional limitation, and functional limitations in a structural claim are only considered to the extent that the structure "is capable of" performing the recited function. In this case Hall is capable of performing the function of patient support. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

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In re Hutchison, 69 USPQ 138. Applicant has further argued that member 40 is between caster rectangular sleeves 54 and caster rectangular mounting tubes 44. However the limitations on which the Applicant relies (the term “configured” recited in claim(s) 1 does not require apparently intimate contact between 44 and 54, and this limitation is not stated in the claim(s)). Therefore, it is irrelevant whether the reference includes those features or not.

Applicant’s arguments with respect to claim(s) 10, 11 have been considered but are deemed moot in view of the new grounds of rejection. With regard to claim(s) 11; applicant has argued that the recitation of the sole amendment distinguishes from Hilborn. However, the relative position of the mounting tube with respect to the frame is(are) constrained to be of a type determined by the application to which the invention is put, and the position of the claimed invention(s) structures has no patentable novelty of and by themselves; and further that the contemplation of these positions is well within the capability of a routineer in the art.

Applicant has pointed out inconsistent characterization between the rejection of claim(s) 1, 2, 8; and that of claim(s) 16 – 20. However, these claim(s) are independent of each other, and the characterization of Hall is to define what elements are applied in each set of independent claim(s), with no necessity for the identical structures of Hall to be identically named in each rejection.

Applicant has argued with regard to the rejection of claim(s) 16 - 20: that Hall does not provide any substantially round cross-sectional shape. However, it has been held that to be entitled to weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

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Conclusion

Claim(s) 4 would be considered allowable if rewritten to correct any objections; or overcome any applicable rejections, under 35 USC 112; and to include all the limitations of the base claim and any intervening claims.

Applicant's amendment to at least claim(s) 1, 11; namely the addition of the phrase "external side walls" necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Bartz whose telephone number is (703)308 - 2564. The examiner can normally be reached on Mondays thru Fridays from 8:30 am to 3:30 pm.

(clifford.bartz@uspto.gov) [Fax -(703)308 - 3519]

If attempts to reach the examiner by telephone are unsuccessful; a message may be left at the Group Receptionist, whose telephone number is (703) 308 - 1113 .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder, can be reached on (703)308- 3421.

Any further inquiry of a general nature or relating to the status of this application may also be directed to the Group Receptionist, whose telephone number is (703) 308 1113.

Clifford T. Bartz

Examiner

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Summary

Total Claim(s) = 1 - 20
Allowed claim(s) = 7, 12
Rejected Claim(s) = 1 - 6, 8 - 11, 13 - 20
Objected claim(s) = 4


JACK LAVINDER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
